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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,124	05/02/2007	Catherine Hedouin	R-03158.US	7098

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EXAMINER
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LEE, DORIS L

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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11/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,124	<b>Applicant(s)</b> HEDOUIN ET AL.	
	<b>Examiner</b> Doris L. Lee	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060512</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 3-6 and 9** are rejected under 35 U.S.C. 102(b) as being anticipated by **Larsen et al (GB 822,276)**.

**Regarding claims 1 and 3**, Larsen teaches an adhesion promoting agent (page 2, lines 4-7) which contains tricresyl phosphate (page 2, line 25).

**Regarding claim 4**, the limitation “is adsorbed onto an inert mineral support selected from the group consisting of silica, alumina, silica-alumina, sodium silicoaluminate, calcium silicate, magnesium silicate, zirconia, magnesium oxide, calcium oxide, cerium oxide and titanium oxide” does not confer patentability to the claim since the recitation of an intended use does not impart patentability to otherwise old compounds or compositions. In re Tuominen, 671 F.2d 1359, 213 USPQ 89 (CCPA 1982).

**Regarding claim 5**, Larsen teaches a water-insoluble film forming polymer composition comprising tricresyl phosphate (Page 2, lines 25-55).

**Regarding claim 6**, Larsen teaches a water-insoluble film forming polymer composition of claim 5 wherein the composition is in the form of an aqueous dispersion (page 2, lines 25-35).

**Regarding claim 9**, Larsen teaches that the polymer composition is polyvinyl acetate (Page 2, line 28). As claim 9 is a product-by-process claim, patentability of said claim is based on the recited product and does not depend on its method of production. Since the product in the instant claim is the same as product disclosed by Larsen the claim is unpatentable even though the polyvinyl acetate product may have been made by a different process. In re Marosi, 710 F2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

3. **Claims 1, 3 and 11** are rejected under 35 U.S.C. 102(b) as being anticipated by **Bradley et al (US 4,473,406)**.

**Regarding claims 1 and 3 and 11**, Bradley teaches a mineral binder composition (col. 1, lines 55-64) comprising tributyl phosphate (col. 3, line 43).

4. **Claims 1, 3 and 11** are rejected under 35 U.S.C. 102(b) as being anticipated by **Aoki et al (US 4,367,300)**.

**Regarding claims 1, 3 and 11**, Aoki teaches a mineral binder composition (col. 4, lines 45-60) comprising tributyl phosphate (col. 4, line 51).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 7 and 8** are rejected under 35 U.S.C. 102(b) as being anticipated by **Larsen et al (GB 822,276)**.

The discussion regarding Larsen in paragraph 1 above is incorporated here by reference.

**Regarding claim 7**, Larsen teaches that the polyvinyl acetate is present in an amount 55 to 60 parts by weight and the tricresyl phosphate is present in an amount of 8 parts by weight (Page 2, lines 25-35). Therefore, the amount of tricresyl phosphate overlaps the claimed range.

**Regarding claim 8**, although Larsen teaches that the polyvinyl acetate is present in an amount 55 to 60 parts by weight and the tricresyl phosphate is present in an amount of 8 parts by weight (Page 2, lines 25-35), it fails to teach that the tricresyl phosphate is present in an amount between 1% and 5% by weight relative to the weight of the latex powder.

It is the examiner's position that the amount of the phosphate ester is a result effective variable because changing it will clearly affect the type of product obtained. See MPEP § 2144.05 (B). Case law holds that "discovery of an optimum value of a

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result effective variable in a known process is ordinarily within the skill of the art.” See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In view of this, it would have been obvious to one of ordinary skill in the art to utilize appropriate amounts of the phosphate ester, including those within the scope of the present claims, so as to produce desired end results.

8. **Claims 12 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Aoki et al (US 4,367,300)**.

The discussion regarding Aoki in paragraph 4 above is incorporated here by reference.

**Regarding claims 12 and 13**, Aoki teaches that the mineral binder is a hydraulic binder such as cement (col. 4, line 60) wherein the amount of tributyl phosphate is 1.4 % of the resin composition (col. 4, lines 45-60). Aoki teaches that the resin composition is used in the range of 5-60% by weight of solid resin based on 100 parts by weight of cement (col. 2, lines 41-47). Therefore the amount of tributyl phosphate overlaps the claimed ranges.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796